

REMARKS

Consideration and entry of this paper are requested. This paper follows two telephonic interviews the undersigned had with Examiner Nguyen on July 22 and July 24, 2009. On behalf of Applicant, the undersigned thanks Examiner Nguyen for his time, patience, and understanding during the interviews.

The July 22nd interview mainly concerned certain terms as used in the claims and differences in the claimed combinations versus the disclosures of Koch.

With respect to claim terms, the following was discussed during the July 22nd interview:

(a) in the specification, Applicant provides a definition of “illumination irregularities”; and (b) Applicant’s definition must be honored when the term is used in the claims. Specifically, a claim term must be read in view of the specification, of which the claims are a part. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315, 75 U.S.P.Q.2d 1321, 1327 (Fed. Cir. 2005 (*en banc*), cert. denied 126 S. Ct. 1332 (2006)). To such end, the Applicants can be their own lexicographer in providing the definition in the specification, and the inventor’s lexicography governs. 37 C.F.R. §1.75(d)(1); *Phillips*, 415 F.3d at 1316, 75 U.S.P.Q.2d at 1327. See also *Finnegan Corp. v. U.S. International Trade Commission*, 180 F.3d 1354, 51 U.S.P.Q.2d 1001 (Fed. Cir. 1999); *Markman v. Westview Instruments Inc.*, 52 F.3d 967, 979, 34 U.S.P.Q.2d 1321, 1330 (Fed. Cir., 1995) (*en banc*), affirmed 517 U.S. 370, 38 U.S.P.Q.2d 1461 (1996); M.P.E.P. §§ 608.01(o) and 2111.01. Where an explicit definition is provided in the specification for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 U.S.P.Q.2d 1383, 1386 (Fed. Cir. 1992). Therefore, whereas the examiner is correct in stating (page 6, line 1, of the Office action) that the “claims define the claimed invention,” Applicant’s definitions must be considered and given due weight. Applicant’s reliance upon his definitions cannot be waved away by the Office action’s allegation that “Applicant is attempting to improperly import limitations from the specification.” The law clearly and convincingly allows Applicant to rely upon definitions provided in his specification. (Notice is hereby made that the line of cases cited above, supporting Applicant’s position, has substantially more legal authority than the M.P.E.P. cited in the Office action. The M.P.E.P. does not have the force of law.) Although Applicant’s reliance upon his definitions arguably

utilizes limitations from the specification, such utilization is not improper under the law.

Applicant also makes the same reply as above to any question about use of the term “reflectivity irregularities.” See Reply of March 12, 2009, page 2, line 27, to page 3, line 10.

During the interview of July 22nd, the Examiner suggested that, in the claims, the term “illumination irregularity” be amended to “uneven illumination distribution.” The Examiner supported this suggestion by contending that such an amendment would not significantly narrow or otherwise alter the scope of the affected claims.

As the undersigned stated during the July 24th interview, Applicant objects to the suggested amendment. First, the term “uneven illumination distribution” is not used in the specification. Second, if such an amendment actually does not change the scope of a claim, then why make the amendment at all? Third, as discussed above and elsewhere in the record, the term “illumination irregularity” is not only defined in the specification but also extensively described with reference to multiple figures and associated text. Fourth, without a more compelling need than has been established in the record, Applicant is unwilling to surrender claim scope under the doctrine of equivalents, according to the *Festo* line of cases, by making amendments that are unnecessary.

During the interview of July 22nd, the Examiner also suggested that, in the claims, the term “reflectivity irregularity” be amended to “reflectivity irregularity region.” The Examiner supported this suggestion by contending, again, that such an amendment would not significantly narrow or otherwise alter the scope of the affected claims. As the undersigned stated during the July 24th interview, Applicant objects to the suggested amendment for the same reasons discussed above.

During the interview of July 22nd, the undersigned carefully explained, with ample reference to FIGS. 2-6 and accompanying text in the specification, key differences of the pending claims versus the disclosure of Koch. That discussion also followed the remarks on pages 2-4 of Applicant’s previous Reply. From that discussion, the undersigned understood Examiner Nguyen to have agreed that the claims are indeed patentably distinguishable from Koch.

In view of the foregoing discussion and the events summarized therein, as well as other discussion in the record, Applicant submits that the pending claims are patentable over Koch (either alone or combined with any other reference of record). Furthermore, the claims are

properly allowable as they are, without having to amend them. Early action to such end is hereby respectfully requested.

It is believed that no fees are required to file this Reply. However, if any fees are required, please charge them to Deposit Account No. 02-4550.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By


Donald L. Stephens Jr.
Registration No. 34,022